

## **REMARKS**

Claims 22-73 are pending in the Application and all have been rejected in the final Office action mailed June 02, 2009. Claims 22, 28, 29, 36, 43, 47, 51 and 60 are amended and new claims 74-81 are added by this response. Claims 22, 28, 29, 36, 43, 47, 51 and 60 are independent claims. Claims 23-27 and 74, claim 75, claims 30-35 and 76, claims 37-42 and 77, claims 44-46 and 78, claims 48-50 and 79, claims 52-59 and 80, and claims 61-73 and 81 depend, respectively, from independent claims 22, 28, 29, 36, 43, 47, 51, and 60.

The Applicants respectfully request reconsideration of pending claims 22-73, and consideration of new claims 74-81, in light of the following remarks.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

## **Amendments to Claims**

Claims 22, 28, 29, 36, 43, 47, 51 and 60 have been amended to clarify the subject matter of the claims. Support for these amendments may be found, for example, at pages 271-277 and Fig. 56a of the Application. Applicants respectfully submit that these amendments do not add new matter.

## **Rejections of Claims**

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter "Richter'706"). Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Perkins. Claims 27, 35, 42, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Weaver et al. (US 5,956,673, hereinafter "Weaver"). Claims 52 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Weaver, and Perkins (US 5,159,592). Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Cripps (US 5,838,730).

Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Harrison et al. (US 5,796,727, hereinafter "Harrison"). Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Harrison and Perkins.

Claims 60, 61, 62, and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton et al. (US 6,108,704, hereinafter "Hutton") and Reimer et al. (US 4,704,696, hereinafter "Reimer"). Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Lewen et al. (US 5,341,374, hereinafter "Lewen"). Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, Lewen, and

McKee et al. (US 5,477,531, hereinafter "McKee"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Cripps.

In addition, the Office rejected claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706 and Perkins. Claims 25, 33, 40, and 55-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706 and Cripps. Claims 26, 34, and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706 and Honig et al. (US 5,481,533, hereinafter "Honig").

The Office also rejected claims 22, 28, 29, 36, and 47 under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Shachar et al. (US 5,764,736, hereinafter "Shachar").

The Office also rejected claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 as being unpatentable over Berken in view of Richter, et al. (WO 94/299979, hereinafter "Richter'979"). Claims 27, 35, 42, 51 and 54 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter'979, and Weaver. Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter'979, and Perkins. Claims 52 and 53 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter'979, Weaver and Perkins. Claims 55 and 56 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter'979, and Cripps.

The Office also rejected claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51, and 54 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver and Richter'979. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver, Richter'979, and Perkins. Claims 25, 33, 40, and 55-59 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver, Richter'979, and Cripps. Claims 26, 34, and 41 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver, Richter'979, and Honig.

**Applicants respectfully point out that the rejection of claims 22, 28, 29, 36, and 47 under 35 U.S.C. §103(a) over Berken and Shachar at Section 30, which begins on page 56 of the instant Office action, is merely a copy of the rejection that appears at Section 20, that begins page 39. This same error appeared in the prior Office action, mailed October 14, 2008, and about which Applicants made note in the response filed April 14, 2009.**

Applicants respectfully note that all of the rejections are for alleged reasons of obviousness over a combination of either Berken or Weaver, and one or more of Richter'706, Richter'979, Harrison, Perkins, Shachar, Cripps, Hutton, Reimer, Lewen, McKee, and Honig.

Applicants first review the requirements for an obviousness rejection. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03. Further, "[**all**] words in a

**claim** must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142, and respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow.

**I. The Proposed Combination Of Berken And Richter'706 Does Not Render Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, And 57-59 Unpatentable**

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706. Applicants respectfully traverse the rejection. The Office rejects independent claims 22, 28, 29, 36, and 47 over Berken and Richter'706 in combination with various supporting references.

Applicants have previously addressed the rejections of the instant Office action in response to prior Office actions. See pages 15-23 of January 9, 2008 response to Office action of July 9, 2007; see pages 19-25 of August 5, 2008 response to Office action of February 6, 2008; see page 14-23 of April 14, 2009 response to Office action of October 14, 2008. Applicants hereby incorporate those responses herein as though set forth in full. Applicants respectfully request reconsideration of the rejection over Berken and Richter'706, and offer the following points for consideration.

As an initial matter, Applicants respectfully note that Applicants' prior responses inadvertently cited the definition of "packet" from page 348 of the Microsoft Press Computer Dictionary – Third Edition, ©1997. That copyright date of 1997 is after Applicants' claimed priority date. Applicants apologize for the oversight. Applicants respectfully submit, however, that an earlier published Microsoft Press Computer

Dictionary, having a copyright date of 1991, uses the same definition that defines a "packet" as "a unit of information transmitted as a whole from one device to another on a network." See *id.* at page 253. Applicants respectfully submit that Microsoft Corporation, a recognized authority in the relevant art, has continued to publish the above definition of the term "packet" since 1991, four years before Applicants' claimed priority date.

The Office again argues that the terms "frame" and "packet" have identical functionality. See Office action of June 2, 2009 at pages 5-6. Applicants have previously challenged this assertion. See pages 20-23 of August 5, 2008 response to Office action of February 6, 2008; see pages 14-20 of April 14, 2009 response to Office action of October 14, 2008. In spite of numerous requests, the Office has not shown any support from any authority, including the cited references, for this conclusory statement. Further, the Office has not responded to requests to explain how and why the Applicants are incorrectly interpreting the teachings of Berken as set forth in Applicants' responses. Therefore, Applicants conclude that the Office agrees with Applicants' understanding of the operation of Berken as set forth in the present and prior responses.

The Office again equates the "frame" of Berken to Applicants' voice packet. See Office action of June 2, 2009 at pages 6-7. Applicants have previously shown support from a recognized authority (i.e., Microsoft Corporation) as evidence for a reasonable definition of the term "packet" as would be known to those of ordinary skill in the art at the time the invention was made. Applicants have shown that the "frame" of Berken does not meet the requirements of the definition of "packet" as defined by the recognized authority. Further, Berken recognizes that the terms "frame" and "packet" are not interchangeable, as further demonstrated by the fact that Berken chose to use the separate and distinct terms "frame" and "packet" in describing the invention. Applicants recognize that claims are to be given their "broadest reasonable interpretation." In spite of this, claims are not to be interpreted in a vacuum. See M.P.E.P. §904.01 and M.P.E.P. §2111. M.P.E.P. §2111.01 also states that "the words of the claim must be given their plain meaning unless the plain meaning is inconsistent

with the specification." M.P.E.P. §2111.01 goes on to say that "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application."

Applicants respectfully submit that Applicants have presented a definition from a recognized authority in the relevant art at the time of the invention (i.e., Microsoft Corporation) as evidence of the plain meaning of the term "packet" to one of ordinary skill in the art in question at the time of the invention.

Applicants respectfully submit that the interpretation/definition of the term "frame" as being equivalent to a "packet" being asserted by the Office is not inconsistent with either Applicants' specification, or the Berken reference. In contrast, the Office has failed to provide any support for its interpretation of the meaning of the terms "frame" and "packet." Applicants respectfully submit that although during examination claims are to be given their broadest reasonable interpretation, such a mandate does not permit the Office to arbitrarily define claim terms without any support for such a definition, particularly in a manner inconsistent with the teachings of the cited art (Berken).

The Office argues that "a packet cannot be transmitted or received without using some address," that "sending a packet over the network is similar to sending the letter/mail over the post office," and that "one must put the destination address on the envelope so that the post office can route the letter/mail over the network of houses/locations." See Office action of June 2, 2009 at pages 8 and 12. Applicants respectfully submit that the Office has specifically selected an example in which the article being transmitted/routed must have the destination address on the article in order to be delivered in that context. Applicants respectfully submit that packets need not comprise destination information/address to be able to be delivered to a network destination. The Office admits to asserting inherency, but has not shown that it is necessarily true that a packet must comprise destination information to be delivered, as required to support a rejection based on inherency. See M.P.E.P. §2112. The Office

has simply cited a chosen example (i.e., involving a letter/mail in the context of the postal system), in which a letter/piece of mail must have an address to be delivered. The fact that a certain example chosen by the Office requires destination information to deliver an item is not proof that all items in all situations require destination information for delivery, as is required to support a rejection based upon inherency. See M.P.E.P. §2112.

To illustrate, Applicants respectfully propose the following simple example that a packet need not comprise destination information to be routed through a network. Assume a network having three nodes, A, B, and C, in which node A is connected to node B, which is connected to node C. Before communicating a packet, node A communicates to node B (via, e.g., a separate communication link between node A and node B) that all packets received by node B on a designated communication link are to be sent by node B to node C. Later, node A sends a packet to node B on the designated communication link, without the packet comprising any form of destination information. Node B, following the instructions received from node A then automatically forwards the packet received from node A, to node C. The packet thus routed need not contain any address or destination information to go from node A through node B to node C. Thus, it is not necessarily true that packets must use destination address/number/information to route through a network. It is, therefore, also not true that the mere use of the term "packet" by Berken teaches that the "packet" of Berken teaches "destination information" (or, to what the Office also refers to as "control information,") used for routing a "packet."

The Office argues that Applicants cannot show non-obviousness by attacking the references individually. Applicants respectfully submit that Applicants' arguments address the alleged teachings of the primary reference as asserted by the Office, and that Applicants also point out that the remaining cited art fails to remedy the shortcoming of the primary references. Therefore, Applicants are not "attacking the references individually," but are properly addressing assertions by the Office of alleged teachings, where the Office does not identify any supporting teachings in the remaining cited art that remedy such shortcomings.



Applicants respectfully maintain that Berken teaches that a "frame" is a unit of time comprising smaller individual units of time referred to as "time slots." *Id.* at pages 4-9. Berken teaches that "time slots" are allocated for use in transporting "packets" from a source to a destination in Berken, according to "appropriate times." *Id.* Berken teaches that a "control time slot" is used to allocate the use of the "times slots" of the "frame" by the source and destination elements. *Id.* The information sent in the "time slots" of a frame is not all sent from one entity of Berken to another entity of Berken, as required by a definition of "packet" as would have been known to one of ordinary skill in the relevant art at the time of the invention. Applicants respectfully submit that asserting that the "frame" of Berken teaches Applicants' "packet" is inconsistent with the teachings identified above and in previous submissions regarding Berken's use of the terms "frame" and "time slot."

Applicants respectfully submit that the Office continues to rely on Richter'706 to remedy the failure of Berken to teach of "destination." See Office action of June 2, 2009 at pages 14, 16, and 19. Applicants respectfully submit that the Office has not shown that Berken discloses a packet comprising information used for routing the packet through the network of Berken. The Office has not shown where Berken teaches that anything in the "packet header" of Berken is used for routing the "packet" through the network of Berken. The mere identification of the "packet header" field of Fig. 4 of Berken is insufficient to conclude that the "packet header," or any other portion of the "packet," contains information used for routing the "packet." Instead, Applicants respectfully maintain that Berken teaches routing by allocating "time slots" between a source and a destination, and passing packets between the source and destination using the allocated "time slot."

Applicants respectfully submit that Richter'706 fails to remedy the shortcomings of Berken, set forth above.

Moreover, even if Applicants were to agree that the Richter'706 reference teaches routing based on "destination information" of a "packet," **which Applicants do not**, the modification of Berken to route such packets would require that Berken be

altered to route based on contents of a "packet header" or some other information of the "packet" rather than on the time in a frame of the allocated "time slot." Applicants respectfully submit that such a modification is a substantial alteration to the elements of Berken that communicate using, for example, the shared "RF channel 107," including but not limited to "switches 11, 213, 175, 193," which would change a fundamental principle of operation of Berken. That is, routing of a "packet" based on inspecting contents of a "packet"/"packet header" is quite different from routing based on an "appropriate time" of an allocated and assigned "time slot," as disclosed by Berken. According to M.P.E.P. §2143.02(VI), "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." Thus, Applicants continue to respectfully submit that the combination of Berken and Richter'706 is improper and without the required motivation.

The Office has attempted to counter this argument by asserting that Applicants are suggesting "bodily incorporation" of the teachings of Richter. See Office action of June 2, 2009 at pages 9-10. That is not the case. The Office is relying on routing of "packets" allegedly taught by Richter'706 to overcome a shortcoming of Berken, by proposing that the teachings of Berken and Richter'706 can be combined to arrive at Applicants' invention. Applicants respectfully submit that the Office has failed to show a motivation to combine the cited teachings, because modifying Berken to employ routing of "packets" based on alleged contents of a "packet header" changes a fundamental operating principle of Berken. Applicants have discussed the operation of Berken in prior responses. See, e.g., response filed April 14, 2009. In spite of requests by the Applicants for the Office to show where Applicants' interpretation of Berken is in error, the Office has not disputed Applicants' interpretation of the operation of Berken, in which "packets" are routed using allocated and assigned "time slots" used to transport "packets" of Berken from one entity to another. Therefore, in accordance with M.P.E.P. §2143.02, Applicants respectfully submit that in addition to the above, there is no motivation to combine Berken with Richter'706.

Notwithstanding the above, Applicants have amended independent claims 22, 28, 29, 36, and 47 to make explicit what would have been implicitly understood by one of ordinary skill in the relevant art at the time of the invention, by adding text that clarifies the nature of a "packet." Further, the Applicants have amended independent claim 22 so that it now recites, in part, "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Independent claims 28, 29, 36, 43, 47, 51, and 60 have been amended to recite similar features. Applicants respectfully submit that Applicants have been unable to discern where Berken and/or Richter'706, or any of the remaining cited art teach or describe at least these aspects of Applicants' claim 22. Therefore, Applicants respectfully submit that amended claim 22 and any claims that depend therefrom are allowable over the cited art. Further, Applicants respectfully submit that because claims 28, 29, 36 and 47 have been amended to recite similar features, claims 28, 29, 36, and 47, and any claims that depend therefrom, are also allowable over the cited art for at least the same reasons as claim 22. Accordingly, Applicants respectfully request that the rejection of claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

## **II. The Proposed Combination Of Berken And Harrison With Or Without Perkins Does Not Render Claims 43-46 Unpatentable**

Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Harrison. Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Harrison and Perkins. Applicants respectfully traverse the rejections.

Applicants have previously addressed the teachings of the proposed combination of Berken and Harrison, and will not repeat those arguments again here. *See, e.g.*, response filed April 14, 2009.

Applicants respectfully maintain that the proposed combination of Berken and Harrison does not teach or suggest all aspects of Applicants' amended independent claim 43. Independent claim 43 now recites, in part, "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the network, wherein a packet is a unit of information transmitted as a whole from one device to another over the network...." In addition, claim 43 now recites "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Applicants have been unable to discern where Berken and/or Harrison teach or suggest at least these aspects of Applicants' amended claim 43. Therefore, Applicants respectfully submit that the proposed combination of references does not teach all aspects of amended claim 43 as required by M.P.E.P. §2143.03 and is allowable over for at least some of the reasons set forth above. For example, Applicants respectfully submit that the Office has not shown where Harrison remedies the shortcomings of Berken described above. Further, the proposed modification of Berken by Harrison, as with Richter'706, changes a fundamental principle of operation of Berken, namely, the routing of "packets" based on contents of a "packet"/"packet header" rather than by allocated and assigned "time slot" of a "frame," therefore a rejection based on a motivation to make such a combination is not supported. See M.P.E.P. §2112.

Applicants respectfully submit that, for at least the reasons set forth above, a *prima facie* case of obviousness has not been established, and the proposed combination of Berken and Harrison does not render Applicants' amended claim 43 unpatentable. Because claims 44-46 depend from allowable claim 43, Applicants respectfully submit that the proposed combination of Berken and Harrison also fails to render claims 44-46 unpatentable, for at least the reasons set forth above. Further, the Office has not shown where Perkins overcomes the deficiencies of Berken and

Harrison. Accordingly, Applicants respectfully request that the rejection of claims 43-46 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**III. The Proposed Combinations Of Berken And Richter'706 With Any Of Weaver, Perkins, And Cripps Do Not Render Claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 48, 49, and 51-56 Unpatentable**

Claims 27, 35, 42, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Weaver. Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Perkins. Claims 52 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Weaver, and Perkins. Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Cripps.

With regard to independent claim 51, Applicants respectfully submit that independent claim 51 now recites, in part, "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network, the processing circuit packetizing the digital voice data according to a packet protocol, wherein a packet is a unit of information transmitted as a whole from one device to another over the communication network...." Claim 51 also now recites "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Applicants respectfully submit that claim 51 recites features similar to claims 22, 28, 29, 36, 43, 47, and 60 that the proposed combination relies on a proposed combination of Berken and Richter'706 that has been addressed above, and that claim 51 is allowable over the proposed combination of Berken and Richter'706 for at least some of the reasons set forth above. Further, Applicants respectfully submit that claims 52-56 depend from allowable claim 51, and are therefore also allowable for at least the same reasons.

Applicants respectfully submit that claims 23, 24, and 27 depend from claim 22, claims 30, 31, and 35 depend from claim 29, claims 37, 38, and 42 depend from claim 36, and claims 48 and 49 depend from claim 47. Therefore, Applicants respectfully submit that those claims are allowable over the proposed combinations of Berken and Richter with any of Weaver, Perkins, and Cripps, in that the Office has not shown where any of Weaver, Perkins, and Cripps overcome the deficiencies of Berken and Richter, and teach all of the features of Applicants' claims 22, 29, 36, and 47. Accordingly, Applicants respectfully request that the rejection of claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 48, 49, and 51-56 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**IV. The Proposed Combinations Of Weaver And Any Of Richter'706, Harrison, Perkins, Cripps And Honig Do Not Render Claims 22-42 And 46-59 Unpatentable**

The Office rejected claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51, and 54 under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706 and Perkins. Claims 25, 33, 40, and 55-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706 and Cripps. Claims 26, 34, and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter'706 and Honig.

With regard to independent claims 22, 28, 29, 36, 47, and 51 Applicants respectfully submit that the proposed combination of Weaver and Richter'706 does not teach all of the limitations of amended claims 22, 28, 29, 36, 47, and 51 as required by M.P.E.P. §2142.

Applicants respectfully submit that the instant Office action at pages 30-34 simply substantially repeats the rejection of the Office action of October 14, 2008 (see pages 30-34). Applicants previously responded to the rejections on April 14, 2009. Applicants will not repeat those arguments here, but hereby incorporate Applicants' prior response herein as if reproduced in its entirety.

In its response to Applicants' arguments of April 14, 2009, the Office, in part, merely repeats portions of the text from the Office action of October 14, 2008, and does not address the specifics of the arguments set forth by the Applicants. The Office also admits to relying upon inherency, but has not provided the support required by M.P.E.P. §2112. See Office action of June 2, 2009 at page 12. Applicants have addressed the failure of the Office to support the allegedly inherent need for "destination information" above. Therefore, Applicants respectfully submit that the Office has not set forth a *prima facie* case based upon inherency regarding the alleged requirement for "destination address/information" in the routing of "packets," for at least the reasons set forth above.

In addition, Applicants respectfully submit that the instant rejection fails to provide the "explicit analysis" or articulated reasoning required by M.P.E.P. §2142. For example, the Office fails to explain how Weaver would be modified by Richter'706 to result in the subject matter of claims 22, 28, 29, 36, 47, and 51. Instead, the Office simply repeats the text of the claim, interspersed with citations to elements and text from the cited references.

Notwithstanding the above, Applicants have amended independent claim 22 so that it now recites, in part, "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Applicants have been unable to identify any text or figure of either Weaver or Richter'706 that teaches or suggests at least these features of amended claim 22. Claims 28, 29, 36, 47, and 51 have also been amended to recite similar features. Therefore, Applicants respectfully submit that claims 22, 28, 29, 36, 47, and 51, and any claims that depend therefrom, are also allowable over the cited at for at least these reasons. Accordingly, Applicants respectfully request that the rejection of claims 22-42 and 47-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

## **V. The Proposed Combinations Of Berken And Hutton Do Not Render Claims 60-73 Unpatentable**

Claims 60, 61, 62, and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Reimer. Applicants respectfully submit that claim 60 and its dependent claims 61-73 are allowable over the proposed combination of Berken, Hutton, and Reimer, for least the reasons set forth above, in that the Office has failed to show where either Hutton or Reimer remedy the deficiencies of Berken, set forth above.

In addition, Applicants have amended independent claim 60 in a manner similar to claims 22, 28, 29, 36, 43, 47, and 51, and respectfully submit that amended claim 60



is allowable over Berken and Hutton. Applicants have been unable to indentify any text or figure of the Berken, Hutton, or remaining cited references that teaches or suggests "at least one processor operating to, at least: ... compare a destination address to a database having at least one entry comprising user defined call routing information and at least one associated destination address" and "cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database," as claimed. Therefore, Applicants respectfully submit that the cited art does not teach or suggest all features of Applicants' amended claim 60. Because claims 61, 62, and 68-73 depend from claim 60, Applicants respectfully submit that claims 61, 62, and 68-73 are also allowable, for at least the same reasons. Applicants respectfully request, therefore, that the rejection of claims 60, 61, 62, and 68-73 under 35 U.S.C. §103(a), be reconsidered and withdrawn.

Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Lewen. Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Lewen, and further in view of McKee. Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Cripps. Applicants respectfully traverse the rejections.

Applicants respectfully submit that claims 63-65, 66, and 67 depend either directly or indirectly from claim 60. Applicants believe that claim 60 is allowable over the proposed combinations of Berken, Hutton, Lewen, McKee, and Cripps, in that Lewen, McKee and Cripps fail to overcome the deficiencies of Berken and Hutton set forth above. Because claims 63-65, 66, and 67 depend from allowable claim 60, Applicants respectfully submit that claims 63-65, 66, and 67 are allowable as well, for at least the same reasons.

In addition, Applicants respectfully maintain that the admitted deficiencies that caused the Office to rely upon Reimer in the rejection of independent claim 60 necessarily exist in Berken and Hutton in regard to all of dependent claims 61-73. The

rejections of claims 63-65, 66, and 67, however, do not recite combinations including Reimer. Therefore claims 63-65, 66, and 67 are allowable over the proposed combinations which are necessarily deficient. Therefore, Applicants respectfully request that the rejections of claims 63-65, 66, and 67 under 35 U.S.C. §103(a), be reconsidered and withdrawn.

Further with respect to all of claims 60-73, Applicants respectfully note that the Office has again failed to respond, let alone successfully overcome Applicants' arguments set forth in the Response filed April 14, 2009 and August 5, 2008 with respect to claims rejected under the proposed combination of Berken and Hutton. See Office action of June 2, 2009 at pages 2-12. The response to Applicants' arguments fails to even mention the rejection over Berken and Hutton, claims 60-73, or Applicants' arguments. Therefore, Applicants respectfully submit that claims 60-73 are allowable over the cited art for at least this additional reason. Accordingly, Applicants respectfully request that the rejection of claims 60-73 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VI. The Proposed Combination Of Berken And Shachar Does Not Render Claims 22, 28, 29, 36, and 47 Unpatentable**

Claims 22, 28, 29, 36, and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Shachar. Applicants respectfully submit that the proposed combination of Berken and Shachar does not teach, suggest, or otherwise render obvious Applicants' claims 22, 28, 29, 36, and 47, in that the Office has failed to show where Shachar remedies the shortcoming of Berken, set forth above. In addition, Applicants has amended independent claim 22 so that it now recites, in part, "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Independent claims 28, 29, 36, and 47 have been amended to recite similar features. Applicants have been unable to identify any text or figure of

Berken and/or Shachar that teaches or suggests at least the above features of Applicants' amended claim 22. Therefore, Applicants believe that amended claims 22, 28, 29, 36, and 47 are allowable over Berken and Shachar. Because claims 23-27, 30-35, 37-46, and 48-50 depend from allowable claims 22, 28, 29, 36, and 47, Applicants respectfully submit that those claims are allowable as well, for at least the same reasons.

In addition, with respect to all of claims 22, 28, 29, 36, and 47, Applicants respectfully note that the Office has again failed to even respond, let alone successfully overcome Applicants' arguments set forth in Applicants' responses of April 14, 2009 and August 5, 2008 with respect to claims rejected under the proposed combination of Berken and Shachar. Therefore, Applicants respectfully submit that claims 22, 28, 29, 36, and 47, and any claims that depend therefrom are allowable for at least this additional reason.

Accordingly, based at least upon the above, Applicants again respectfully request that the rejection of claims 22, 28, 29, 36, and 47 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VII. The Proposed Combinations Of Berken With Any Of Richter '979, Weaver, Perkins, And Cripps Do Not Render Claims 22-42 And 47-59 Unpatentable**

The Office rejected claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 as being unpatentable over Berken in view of Richter '979. Claims 27, 35, 42, 51 and 54 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter '979, and Weaver. Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter '979, and Perkins. Claims 52 and 53 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter '979, Weaver and Perkins. Claims 55 and 56 were rejected as being unpatentable under 35 U.S.C. §103(a) over Berken, Richter '979, and Cripps. Applicants respectfully traverse the rejections.

Applicants respectfully submit that all of the rejections are based upon Berken and Richter '979. Applicants respectfully submit that independent claims 22, 28, 29, 36,

47, and 51 are allowable over the proposed combination of Berken and Richter '979 for at least some of the reasons set forth above with respect to Richter'706. Further, Applicants respectfully submit that independent claims 22, 28, 29, 36, 47, and 51 are also allowable over Berken, Richter '979, and any combination of Weaver, Perkins, and Cripps, in that the Office has not shown where Weaver, Perkins and Cripps overcome the deficiencies of Berken and Richter '979.

In addition, Applicants have amended independent claim 22 so that it now recites, in part, "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Independent claims 28, 29, 36, 47, and 51 have been amended to recite similar features. Applicants have been unable to identify any text or figure of Berken and/or Richter'979 that teaches or suggests at least the above features of Applicants' amended claim 22. Therefore, Applicants believe that amended claims 22, 28, 29, 36, 47, and 51 are allowable over Berken and Richter'979. Because claims 23-27, 30-35, 37-46, 48-50, and 52-59 depend from allowable claims 22, 29, 36, 47, and 51, Applicants respectfully submit that those claims are allowable over Berken and Richter'979 as well, for at least the same reasons. Applicants further respectfully submit that claims 22, 28, 29, 36, 47, and 51, and any claims that depend therefrom, are also allowable over the proposed combinations of Berken, Richter'979, Weaver, Perkins, and Cripps, for at least the reasons set forth above. Accordingly, Applicants respectfully request that the rejections of claims 22-42 and 47-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VIII. The Proposed Combinations Of Weaver With Any Of Richter'979, Perkins, Cripps, And Honig Do Not Render Claims 22-42 And 47-54 Unpatentable**

The Office also rejections claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51, and 54 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver and Richter'979. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected as being

unpatentable under 35 U.S.C. §103(a) over Weaver, Richter'979, and Perkins. Claims 25, 33, 40, and 55-59 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver, Richter'979, and Cripps. Claims 26, 34, and 41 were rejected as being unpatentable under 35 U.S.C. §103(a) over Weaver, Richter'979, and Honig. Applicants respectfully traverse the rejections.

Applicants respectfully submit that all of the rejections are based upon Weaver and Richter'979. Applicants respectfully submit that independent claims 22, 28, 29, 36, 47, and 51 are allowable over the proposed combination of Weaver and Richter'979 for at least some of the reasons set forth above. Further, Applicants respectfully submit that independent claims 22, 28, 29, 36, 47, and 51 are also allowable over Weaver, Richter'979, and any combination of Perkins, Cripps, and Honig, in that the Office has not shown where any of Perkins, Cripps, and Honig overcome the deficiencies of Weaver and Richter'979, set forth above.

Notwithstanding the above, Applicants have amended independent claim 22 so that it now recites, in part, "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Independent claims 28, 29, 36, 47, and 51 have been amended to recite similar features. Applicants have been unable to identify any text or figure of Weaver and/or Richter'979 that teaches or suggests at least the above features of Applicants' amended claim 22. Therefore, Applicants believe that amended claims 22, 28, 29, 36, 47, and 51 are allowable over Weaver and Richter'979. Because claims 23-27, 30-35, 37-46, 48-50, and 52-59 depend from allowable claims 22, 29, 36, 47, and 51, Applicants respectfully submit that those claims are allowable over Weaver and Richter'979 as well, for at least the same reasons.

Applicants further respectfully submit that claims 22, 28, 29, 36, 47, and 51, and any claims that depend therefrom are also allowable over the proposed combinations of

Weaver, Richter '979, Perkins, Cripps, and Honig for at least the reasons set forth above. Accordingly, Applicants respectfully request that the rejections of claims 22-42 and 47-54 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **Newly Added Claims**

Applicants have added new claims 74-81 that depend, respectively, from independent claims 22, 28, 29, 36, 43, 47, 51, and 60. Applicants respectfully submit that support for new claims 74-81 may be found, for example, at pages 271-277 and Fig. 56a of the Application. Applicants respectfully submit that these amendments do not add new matter.

## **Conclusion**

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-80 define patentable subject matter and are in condition for allowance.

Should the Examiner disagree or have any questions regarding this submission, or have any suggestions to move the Application to allowance, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees required by this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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